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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/799,395

03/11/2004

David P. Mitchell

GEO-59

7325

7590

05/02/2006

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EXAMINER

STASHICK, ANTHONY D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

6

<b>Office Action Summary</b>	<b>Application No.</b> 10/799,395	<b>Applicant(s)</b> MITCHELL, DAVID P.	
	<b>Examiner</b> Anthony Stashick	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>07122004</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 31 and 32 are rejected under 35 U.S.C. 101 because they fail to describe the method of producing footwear in such a way as to create something that is concrete. The limitations of the claims only list the function of providing, but do not produce a concrete definitive product. The mere statement of providing parts for production is not a proper way of describing a method of producing a product. It is not clear as to what applicant is attempting to claim as the method of producing footwear.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 31 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 31 and 32 contain limitations that fail to define a proper method for producing the concrete product of footwear as claimed in the preamble. Applicant has only listed steps for providing portions of the product but has failed to put these portions together to form a concrete product.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6, 8-9, 11-18, 20-27 and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by the WO reference to Kneissl Dachstein Sportartikel WO 93/12685 (WO '685). WO '685 discloses all the limitations of the claims including the following: an upper 4; and outsole 1; a cushioned insert 7, 8 having a bottom extension (see Figure 1, bottoms of 7 and 8); an insole 3 having at least one opening therein (see Figure 1 where 7 and 8 are inserted into 3), the insole being configured to accommodate the bottom extension of the cushioned insert (see Figure 1); a covering 2 over the at least one opening (see Figure 1); the outsole 1 is formed of injectable material (rubber is injectable by injection molding); the covering 2 over the insole is an expandable material (known to expand or stretch with compression of 18); the bottom extension on the cushioned insert comprises a heel portion (see bottom of 7 in Figure 1); the insole opening, with the covering thereon, is in the backpart section of the insole and receives the heel portion of the cushioned insert (see Figure 1); the covering over the insole opening is an expandable material (known to expand or stretch with compression of 18); the insole opening is in a forepart section and receives a front portion of the cushioned insert (see Figure 1 with respect to the bottom of 8); the insole including a peripheral outer portion 3 formed of a first material (see page 9, lines 1-12) and an inner portion 7, 8 surrounded by the peripheral outer portion (see Figures 1-4) and formed of a second material 18 (cork or plastic particles); the

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second material is an expandable material (cork or plastic particles); the peripheral outer portion and the inner portion are in the forepart section of the insole (see Figures 1-4); the second material is expandable material (cork or plastic particles); the peripheral outer portion and the inner portion are in the backpart section of the insole (see Figures 1-4); forepart and backpart portions are formed of a first outer portion formed of a first outer peripheral material and a second inner portion formed of a second material (See Figures 1-4); the second material is expandable (cork or plastic particles)

7. Claims 1-6, 8-9, 11-18, 20-27 and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by the Dean 6,519,874. Dean '874 discloses all the limitations of the claims including the following: (see Figure 2) an upper (shown in phantom in Figure 2); and outsole 30, 40; a cushioned insert 96 having a bottom extension (see Figure 2, bottom extension is 70, 72, 76); an insole 94 having at least one opening therein (see Figure 2 where 70, 72, 76 are inserted into 60), the insole being configured to accommodate the bottom extension of the cushioned insert (see Figure 2); a covering 98 over the at least one opening (see Figure 2); the outsole 30, 40 is formed of injectable material (rubber, see col. 2, lines 47-48, is injectable by injection molding); the covering 98 over the insole is an expandable material (foam layer known to expand or stretch with compression of heel section); the bottom extension on the cushioned insert comprises a heel portion (see Figure 2); the insole opening, with the covering thereon, is in the backpart section of the insole and receives the heel portion of the cushioned insert (see Figure 2); the covering over the insole opening is an expandable material (known to expand or stretch with compression of heel section); the insole opening is in a forepart section and receives a front portion of the cushioned insert (see Figure 2 with respect to the bottom of 116); the insole

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including a peripheral outer portion 94 formed of a first material (see col. 3, lines 29-40) surrounded by the peripheral outer portion (see Figure 2) and formed of a second material (see col. 3, line 63-col. 4, line 7); the second material is an expandable material (foam-type); the peripheral outer portion and the inner portion are in the forepart section of the insole (see Figure 2); the second material is expandable material (foam-type); the peripheral outer portion and the inner portion are in the backpart section of the insole (see Figure 2); forepart and backpart portions are formed of a first outer portion formed of a first outer peripheral material and a second inner portion formed of a second material (see Figure 2); the second material is expandable (foam-type).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 7, 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of the references as applied above in view of Weis 6,711,836. Each of the references as applied above disclose all the limitations substantially as claimed except for the outsole having an opening for receiving the lower heel portion of the cushioned insert. Weis '836 teaches that the lower heel portion 18 of an insert can be received in an opening 24 of the outsole to aid in cushioning the impact of the user's heel with the ground. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to have an opening in the

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outsole of either of the references as applied above, to receive the lower heel portion of the cushioned insert, as taught by Weis 836, to aid in cushioning the impact of the user's heel with the ground.

10. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Kneissl Dachstein Sportartikel WO 93/12685 (WO '685) or Dean 6,519,874 in view of Official Notice. (WO '685) or Dean 6,519,874 discloses all the limitations of the claim except the outsole being formed of polyurethane. Official Notice is taken that it is well known in the art of shoemaking to use polyurethane for an outsole to gain the well-known benefits of light in weight and durability and resistance to wear. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the outsole of (WO '685) or Dean 6,519,874 to make the shoe lighter in wear yet continually durable for longtime use.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections

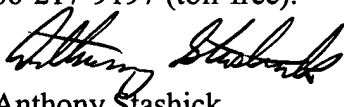
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to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS